UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,466	12/23/2003	Takeshi Ootsuka	P24111	8142

7055 7590 06/15/2007
GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER	
TURCHEN, JAMES R	

ART UNIT	PAPER NUMBER
2139	

NOTIFICATION DATE	DELIVERY MODE
06/15/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No.	Applicant(s)	
	10/743,466	OOTSUKA ET AL.	
	Examiner	Art Unit	
	James Turchen	2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 19-28 are pending. Claims 19-28 are new. Claims 1-18 are cancelled.

Response to Arguments

Applicant's arguments with respect to claims 19-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19, 21, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. (US 6,148,333) in view of Kraslavsky et al. (US 5,537,626).

Regarding claims 19 and 25-27:

Guedalia et al. discloses method and system of having an image database (column 9 line 62) which stores original data (inherently on a hard drive (first memory)), having a second memory (column 10 lines 23-29, a database inherently has RAM which is where the watermark is stored before applying to the file), and a third memory that stores an access right associated with the user ID (column 10 lines 15-19, user database 105). Guedalia et al. also discloses when a user at a terminal requests a file (a terminal inherently has a controller (CPU), and input device (mouse/keyboard)), the server (with a controller (CPU)) adds a watermark based upon the user's username and privilege and the file's policy and transmits the file (column 10 lines 23-67 to column 11 lines 1-13). It is inherent that the original data (unmodified data) is transformed into image data in order to add the watermark. Guedalia does not disclose a method or system of printing. Kraslavsky discloses a basic network set up with printers connected to a file server and a printer connected to a local terminal (figure 1, PC 22 is connected to PTR 2 and File Server 30 is connected to PTR 32 and 34). It would have been obvious to one of ordinary skill in the art at the time of invention that one could print on a local printer or have the file server print the file that the user received, and based on the user's access rights, the pc or the server printer would print the watermarked image or the original data (whichever the user received). It would have been obvious to add printers to allow the user to physically reproduce the documents onto paper.

Regarding claim 21:

Guedalia et al. discloses the use of a server. It is inherent for a server to replace items in cache with a more recently used item in order to make it quicker to access.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia and Kraslavsky as applied to claim 19 above, and further in view of Nakao et al. (2001/0054152).

Guedalia and Kraslavsky disclose all of the limitations of claim 19, but they do not disclose a print log. Nakao discloses a print log and recording information that was printed into the print log (paragraph 183). It would have been an obvious improvement to further include the file that was printed and by whom it was printed. It would have been obvious to one of ordinary skill in the art to combine the system disclosed in claim 19 with the print log of Nakao in order to keep track of printer usage (paragraph 183).

Claims 22, 23, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia in view of Stefik et al. (2001/0008557).

Regarding claims 22, 23, 24 and 28:

Guedalia discloses method and system of having an image database (column 9 line 62) which stores original data (inherently on a hard drive (first memory)), having a second memory (column 10 lines 23-29, a database inherently has RAM which is where the watermark is stored before applying to the file), and a third memory that stores an access right associated with the user ID (column 10 lines 15-19, user database 105). Guedalia et al. also discloses when a user at a terminal requests a file (a terminal inherently has a controller (CPU), and input device (mouse/keyboard)), the server (with a controller (CPU)) adds a watermark based upon the user's username and privilege and the file's policy and transmits the file (column 10 lines 23-67 to column 11 lines 1-13). It is inherent that the original data (unmodified data) is transformed into image data

in order to add the watermark. Guedalia additionally discloses having a privileged user and a non-privileged user group (column 11 lines 12-48). Guedalia does not disclose a watermark related to user ID and document ID. Stefik discloses having the username in the watermark of a specific document along with other various information such as document name and place of printing (Figure 6, 616-617). The watermark is selected and added to the document. It is possible to select and use multiple watermarks. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system to include a watermark for a folder (the path name) or a user group in order to watermark the document with a user group's or a folder's watermark (path name). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the image server of Guedalia with the system of Stefik that includes the username in the in order to specify the "fingerprint" information associated with the printing of the digital work (Stefik, paragraph 102).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Turchen whose telephone number is 571-270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571)272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRT

TAGHI ARANI
PRIMARY EXAMINER
6/8/07